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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,171	02/25/2002	Marjorie Faith Zarin	03292.101250	8691
66569	7590	06/14/2007		
FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER NEWTON, JARED W	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/082,171	<b>Applicant(s)</b> ZARIN ET AL.	
	<b>Examiner</b> Jared W. Newton	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 59-106 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Final Rejection is in reply to the remarks filed March 27, 2007, by which claims 1-58 were canceled, and claims 59-106 were added.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 68, 76, 82, 92, and 106 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "normal" in the claims is a relative term that renders the claim indefinite. The term "normal" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 59-106 are rejected under 35 U.S.C. 102(e) as being anticipate by US Patent No: 6,978,369 to Wheeler et al. (hereafter Wheeler).

In regard to claim 59, Wheeler discloses a system and method for establishing accounts and managing a database of existing accounts, said method comprising: receiving an access code ("public key" or "account identifier" see col. 12, line 60 – col. 13, line 16); determining, based on the access code, whether an accessing party is a pre-existing customer (see generally col. 14, lines 17-67) or a prospective customer (see col. 12, line 60 – col. 13, line 16); determining, if the accessing party is a pre-existing customer, whether at least one pre-approved offer exists for the pre-existing customer (see col. 14, lines 32-36); and determining, if the accessing party is a prospective customer, the validity of the access code (see col. 13, lines 17-19) and associating the access code with at least one of a customer profile and a pre-approved offer (see col. 12, line 60 – col. 13, line 16).

In regard to claim 60, Wheeler further discloses matching the access code to a pre-existing customer profile in a pre-existing customer database (see col. 14, lines 19-27).

In regard to claim 61, Wheeler further discloses the offer associated with a pre-existing customer profile (see id.).

In regard to claim 62, Wheeler further discloses providing the pre-approved offer in an application for a transaction account (i.e. "converting a pre-existing account into an ABDS account." See generally col. 14, lines 17-67), wherein said account is, for example, a credit card account (see col. 15, lines 24-55).

In regard to claim 63, Wheeler discloses said database including customer information displayed in modifiable data entry fields (see e.g. FIG. 19).

In regard to claim 64, Wheeler further discloses validation of the pre-existing customer profile (see col. 14, lines 38-40).

In regard to claim 65, Wheeler further discloses approving the application for the transaction account (see e.g. col. 14, lines 38-46), but does not explicitly disclose said approval occurring in real-time. However, Wheeler does disclose the transaction occurring over a computer network (see col. 9, lines 41-57), and said communications inherently occur in "real-time."

In regard to claim 66, Wheeler further discloses providing transaction account information (see e.g. FIG. 19).

In regard to claim 67, Wheeler further discloses said modifiable data entry fields as modified (see e.g. FIG. 19).

In regard to claim 68, *insomuch as understood in view of 35 U.S.C. § 112 rejection set forth above*, Wheeler further discloses said transaction processing occurring under normal procedures, and providing a message informing that the application for the transaction account is processed under normal processing procedures (see e.g. col. 13, line 63 – col. 14, line 16).

In regard to claim 69, Wheeler further discloses matching the access code ("public key" or "account identifier") to a pre-approval code ("private key" see col. 14, lines 32-37).

In regard to claim 70, Wheeler further discloses providing the pre-approved offer in an application for a transaction account (i.e. "converting a pre-existing account into an ABDS account." See generally col. 14, lines 17-67), wherein said account is, for example, a credit card account (see col. 15, lines 24-55).

In regard to claim 71, Wheeler further discloses modifiable entry fields as set forth above.

In regard to claim 72, Wheeler further discloses validating a pre-existing customer profile (see col. 14, lines 38-40).

In regard to claim 73, Wheeler further discloses approving the application for the transaction account (see e.g. col. 14, lines 38-46), but does not explicitly disclose said approval occurring in real-time. However, Wheeler does disclose the transaction occurring over a computer network (see col. 9, lines 41-57), and said communications inherently occur in "real-time."

In regard to claim 74, Wheeler further discloses providing transaction account information (see FIG. 19).

In regard to claim 75, Wheeler further discloses said modifiable data entry fields as modified (see e.g. FIG. 19).

In regard to claim 76, *insomuch as understood in view of 35 U.S.C. § 112 rejection set forth above*, Wheeler further discloses said transaction processing occurring under normal procedures, and providing a message informing that the application for the transaction account is processed under normal processing procedures (see e.g. col. 13, line 63 – col. 14, line 16).

In regard to claims 77-82, Wheeler further discloses the method set forth above in the rejection of claims 59-76, wherein said method is alternatively applied in the case of a prospective account holder (see col. 12, line 60 – col. 14, line 16). Therefore, claims 77-82 are deemed anticipated by the Wheeler reference.

In regard to claims 83-106, Wheeler discloses a system for executing the steps of the method set forth in the rejection of claims 59-82 set forth above. Wheeler further discloses a transaction account provider (“account authority”) that inherently includes a server for effecting communication between the customer 202 and account database 214 (see FIG. 2)); a customer interface (“I/O support element” see col. 9, lines 50-57) configured to receive the access code and provide the access code to the transaction account provider server; and a customer database 214 (see FIG. 2) in communication with the server (see FIG. 2).

### ***Response to Arguments***

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

The substitute specification filed March 27, 2007 is acknowledged and entered herein.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent Application Publication No. 2002/0052776 to Rothman et al.
- US Patent Application Publication No. 2006/0136306 to Rothman et al.
- US Patent No. 5,644,723 to Deaton et al.
- US Patent No. 6,434,534 to Walker et al.
- Valentine, *The secret world of selling cards on the web*, ABA Banking Journal, Sept. 1999.
- Fitzgerald, *Getting more out of direct mail*, Credit Card Management, March 2000.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

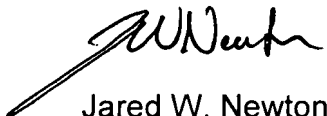


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jared W. Newton  
June 6, 2007  
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